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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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09/369,747 08/06/99 HUEBNER

V	1534-004
EXAMINER	

HM22/0202

CHIRON CORPORATION  
INTELLECTUAL PROPERTY - R440  
P O BOX 8097  
EMERYVILLE CA 94662-8097

ART UNIT	PAPER NUMBER
1626	7

DATE MAILED:

02/02/01

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 1-69 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-69 are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

—SEE OFFICE ACTION ON THE FOLLOWING PAGES—

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-21, 54, drawn to various products, variously classified;
- II. Claim 22-53, 55, drawn to various products, variously classified;
- III. Claims 56, 57, drawn to various methods of treating with various compounds, variously classified;
- IV. Claims 58, 59, drawn to various methods of treating with various compounds, variously classified;
- V. Claims 60, 61, drawn to various methods of preventing diseases with various compounds, variously classified;
- VI. Claims 62, 63, drawn to various methods of preventing diseases with various compounds, variously classified;
- VII. Claims 64-66, drawn to methods of modulating biological activity of an estrogen receptor using various compounds, variously classified;
- VIII. Claims 67-69, drawn to methods of modulating biological activity of an estrogen receptor using various compounds, variously classified;

The above groups are identified as general areas. Accordingly, as groups they are independent or distinct as the various product groups differ materially in structure and element, the products would be capable of more than one use as is clearly obvious from the claims and separate search considerations are involved. Moreover to not restrict would impose a burden on the examination of this application.

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The above groups themselves are inclusive of patentably distinct subject matter.

Accordingly, along with the election of one of the above groups the following action is also taken.

Claims 1, 22, 56, 58, 60, 62, 64 and 67 are generic to a plurality of disclosed patentably distinct species comprising for example, the compounds (1) 5.1.21., (2) 5.1.2.5, (3) 5.1.2.43, (4) 5.1.2.243, <sup>etc.</sup> ~~etc.~~, the method of treating (5) osteoporosis with the compound 5.1.21, (6) 5.1.2.5, etc., (7) the method of preventing breast cancer with the compound of 5.1.21, etc. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Upon the election of a single disclosed species, a generic concept inclusive of the elected species will be identified by the Examiner for examination along with the elected species.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

An attempt was made to present the restriction requirement telephonically but not result in an election being made.

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Any inquiry concerning this communication should be directed to R.W. Ramsuer at  
telephone number (703) -308-4534.

Ramsuer/LR

January 31, 2001



Robert W. Ramsuer  
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